

Appln No. 09/650,482
Amdt date June 14, 2007
Reply to Office action of December 14, 2006

REMARKS/ARGUMENTS

Applicants appreciatively acknowledge the Examiner's acceptance of the amendments filed on September 25, 2006 as overcoming the outstanding objections to the claims, drawings, specification, and title and overcoming the rejection of claims 1, 14, and 16-27 under 35 U.S.C. 112, second paragraph.

In the Office action dated December 14, 2006, the Examiner has raised a new rejection of claims 1, 14, and 16 under 35 U.S.C. 112, second paragraph, "as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See M.P.E.P. § 2172.01. The omitted steps are: After limitation one there is a gap between the claim limitations. Another limitation is needed after 'the at least one pharmacy client is configured to accept and process orders for medications', 'the service center client system' and the 'pharmacy network configured with a global database . . .'" Office action, pp. 2-3. Applicants respectfully traverse this rejection.

Applicants submit that no legal or factual grounds for the Examiner's rejection have been shown in the Office action and, as such, the Examiner has not made out a *prima facie* showing that the rejection is well founded. More particularly, the legal reason for the rejection specified by the Examiner, "incomplete for omitting essential steps, such omission amounting to a gap between the steps" is not a proper legal ground for making a rejection under 35 U.S.C. 112, second paragraph. As stated in M.P.E.P § 2172.01, cited by the Examiner, "a claim which fails to interrelate essential elements of the invention *as defined by applicant(s) in the specification* may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention." (emphasis added). The Examiner has not claimed that the rejected claims "fail[] to interrelate essential elements of the invention *as defined by applicant(s) in the specification*," but rather merely stated that there is some unspecified missing element ("another limitation is needed here"), without any reference to the specification.

Looking beyond the stated grounds for the Examiner's rejection, a rejection on grounds of something similar to the Examiner's "incomplete for omitting essential steps" is also discussed in M.P.E.P. § 2172.01 that is cited by the Examiner, namely: "A claim which omits

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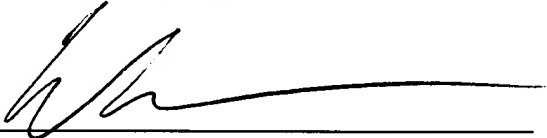
matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, *first* paragraph, as not enabling.” (emphasis added). If this is the rejection that was intended by the Examiner, the Examiner has made no showing to support such a rejection. More specifically, a rejection of a claim for omitting essential matter requires that the claim “omits matter *disclosed* to be essential to the invention *as described in the specification or in other statements of record.*” The Examiner has not pointed to any matter that is disclosed to be essential to the invention as described in the specification or in other statements of record that is not in the rejected claims and applicants are aware of none. As such, even if the Examiner intended to reject claims 1, 14, and 16 under 35 U.S.C. 112, first paragraph, as discussed in M.P.E.P. § 2172.01, the Examiner has not made any showing that this rejection is well founded and, in particular, has not pointed to any matter, specifically or generally, that is disclosed to be essential to the invention but is not included in the claims.

Claims 2-13, 15, and 17-27 were rejected because they depend from a rejected base claim. As the rejection of the base claims was improper, as discussed above, the rejection of claims 2-13, 15, and 17-27 are respectfully traversed for the same reasons as stated above with respect to claims 1, 14, and 16.

As it is believed that all of the claims are in condition for allowance, reconsideration of the rejection in the Office action dated December 14, 2006 is respectfully requested.

Respectfully submitted,
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